PATENT APPLICATION

ATTORNEY DOCKET NO. __10004840-1__

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): John C. Crandall

Confirmation No.: 6310

Application No.: 09/822,152

Examiner: J. D. Schlaifer

Filing Date: 03/30/2001

Group Art Unit: 2178

Title: DOCUMENT INTELLIGENCE CENSOR

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on __04/21/2005__ .

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

( )	one month	$120.00
( )	two months	$450.00
( )	three months	$1020.00
( )	four months	$1590.00

( ) The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.
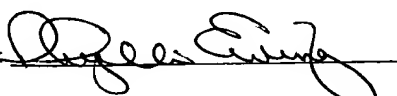
Please charge to Deposit Account **08-2025** the sum of ___$500.00___ . At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

"Express Mail" label no. EV629198005US

Date of Deposit 06/21/2005

I hereby certify that this is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Director for Patents, Alexandria, VA 22313-1450.

Typed Name: Phyllis Ewing

Signature:

Respectfully submitted,

John C. Crandall

By _____

R. Ross Viguet

Attorney/Agent for Applicant(s)
Reg. No. **42,203**

Date: **06/21/2005**

Telephone No.: **(214) 855-8185**

Rev 12/04 (Aplbrief)

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

Docket No.: 10004840-1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
John C. Crandall

Application No.: 09/822,152

Confirmation No.: 6310

Filed: March 30, 2001

Art Unit: 2178

For: DOCUMENT INTELLIGENCE CENSOR

Examiner: J. D. Schlaifer

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on April 21, 2005, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

I.	Real Party In Interest
II.	Related Appeals and Interferences
III.	Status of Claims
IV.	Status of Amendments
V.	Summary of Claimed Subject Matter
VI.	Grounds of Rejection to be Reviewed on Appeal
VII.	Argument
VIII.	Claims
IX.	Evidence

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Hewlett-Packard Development Company, L.P., a Texas Limited Partnership having its principal place of business in Houston, Texas.

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A.   Total Number of Claims in Application

There are 20 claims, numbered 1-20, pending in application.

B.   Current Status of Claims

1.   Claims canceled: None

2.   Claims withdrawn from consideration but not canceled: None

3.   Claims pending: 1-20

4.   Claims allowed: None

5.   Claims rejected: 1-20

C.   Claims On Appeal

The claims on appeal are claims 1-20.

IV. STATUS OF AMENDMENTS

Appellant filed an Amendment After Final Rejection on March 17, 2005 in response to a final Office Action, mailed January 27, 2005, rejecting of all of the claims. The March

17 filing amended claim 9. The Appellee responded with an Advisory Action, mailed April 5, 2005, in which the Appellee indicated that Appellant's proposed amendment would be entered. Accordingly, the claims enclosed herein as Appendix A incorporate the amendment to claim 9 as indicated in the Amendment After Final Rejection.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

According to one embodiment, a computerized document censor comprises a censor database of restricted terms (100; page 6, paragraph 1, lines 2-5), a text comparator program for finding ones of said restricted terms in said document (101; page 6, paragraph 1, line 3), and a text highlighter program for highlighting said restricted terms found in said document (102; page 6, paragraph 1, lines 5-8). (100 appears in figures 1-3; 101 and 102 appear in figure 1.)

According to another embodiment, a method for censoring a document comprises the steps of storing, by a computer (20; page 7, paragraph 4, lines 2-3), a list of prohibited expressions (500; page 11, paragraph 2, lines 2-3; page 9, paragraph 2, lines 1-2), filtering said document using said computer to find ones of said prohibited expressions (501, figure 5; page 11, paragraph 2, lines 3-4); and visibly marking ones of said prohibited expressions found in said document (502; page 11, paragraph 2, lines 4-6). (20 appears in figure 2; 500, 501, 502 appear in figure 5.)

According to another embodiment, a computer program product having a computer readable medium having computer program logic recorded thereon for reviewing a document for restricted expressions comprises means for storing a list of said restricted expressions (20, 100, 500; page 11, paragraph 2, lines 2-3; page 8, paragraph 3, lines 2-4), means for searching said document to find ones of said restricted expressions (20, 101, 501; page 6, paragraph 1, line 3; page 11, paragraph 2, lines 3-4); and means for visibly marking ones of said restricted expressions found in said document (103, 502; page 11, paragraph 2, lines 4-5; page 6, paragraph 1, lines 6-8). (20 appears in figures 2-3; 100 appears in figures 1-3, 101, 103 appear in figure 1; 500, 501, 502 appear in figure 5.)

According to another embodiment, the computer program product further comprises means for storing a list of generalized expressions corresponding to said restricted

expressions (20, 104, 503; page 11, paragraph 2, lines 6-7; page 4, paragraph 2, lines 5-7), and means for presenting a group of said generalized expressions corresponding to ones of said restricted expressions found in said document (30, 504; page 11, paragraph 2, lines 10-11; page 8, paragraph 4, lines 1-2). (20 appears in figures 2-3; 30 appears in figure 3; 104 appears in figures 1-3; 503, 504 appear in figure 5.)

According to another embodiment, the means for storing said list of said restricted expressions comprises at least one of: means for entering restricted words (20; page 10, paragraph 1, lines 1-2), means for entering restricted phrases (20; page 11, paragraph 3, lines 1-3), and means for entering rules of restricted communication relationships (Id.). (20 appears in figures 2-3.)

According to another embodiment, the means for storing said list of said generalized expressions comprises at least one of: means for entering generalized words (20; page 10, paragraph 1, lines 2-3), means for entering generalized phrases (20; page 11, paragraph 3, lines 1-3), and means for entering rules of generalized communication relationships (Id.). (20 appears in figures 2-3.)

According to another embodiment, the computer program product further comprises means for selecting a corresponding generalized expression from said presented group of said generalized expressions (30; page 8, paragraph 4, lines 1-2; page 11, paragraph 2, lines 10-12); and means for replacing said restricted expression found in said document with said selected corresponding generalized expression (30, 505; page 8, paragraph 4, lines 10-11; page 11, paragraph 2, lines 11-12). (30 appears in figure 3; 505 appears in figure 5.)

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 9-15 are properly rejected under 35 U.S.C. § 101.

Whether claims 1, 9, and 16 properly stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,075,550 to Lapierre (hereinafter *Lapierre*), in view of US Patent No. 6,184,885 to DeStefano (hereinafter *DeStefano*).

Whether claims 2, 4, 10, and 17 properly stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and further in view of US Patent No. 5,832,212 to Cragun et al. (hereinafter *Cragun*).

Whether claims 6, 13, and 20 properly stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and *Cragun* and further in view of US Patent No. 5,757,417 to Aras et al. (hereinafter *Aras*).

Whether claim 8 properly stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and *Cragun* and further in view of US Patent No. 6,304,881 to Halim et al. (hereinafter *Halim*).

Whether claim 15 properly stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and *Cragun* and further in view of US Patent No. 6,393,464 to *Dieterman*.

VII.   ARGUMENT

A.   General

Claims 1-20 are pending in the present application. Claims 1-20 stand rejected under 35 U.S.C. § 103. Claims 9-15 stand rejected under 35 U.S.C. § 101. Appellant respectfully traverses the rejections of record.

B.   35 U.S.C. § 101 Rejection

Claims 9-15 were rejected under 35 U.S.C. § 101 because the "claims describe a claim that could be performed by hand by a human being, and lack a technological basis such as a computer that is required to be statutory subject matter," see the final Office Action at page 2. In rejecting these claims, the Appellee does not identify any authority upon which the rejection is based, but rather baldly asserts that the process recited therein lacks a technological basis such as a computer that is required to be statutory subject matter.

Appellant has reviewed 35 U.S.C. § 101 and is unable to identify any portion of the statute which requires anything further than a "process" for claims 9-15 to fall into a statutory

class of subject matter. The Appellee has not asserted that these claims are not a process, and therefore appears to be in agreement that the claims recite a process. Appellant respectfully asserts that claims 9-15, reciting a process, comprise statutory subject matter under 35 U.S.C. § 101.

Although the Appellee asserts that a technological basis such as a computer is required to make claims 9-15 fall into a statutory class of subject matter, such does not appear to be the law. Processes as statutory subject matter have a very early history in United States patent law. For example, although not expressly including "processes" in the definition of statutory subject matter, the phrase "any art" as included in the Patent Act of 1793 was interpreted to encompass processes, see e.g., *Corning v. Burden*, 56 U.S. (15 How.) 252 (1853). Clearly a computer could not have been required in order for a process to be considered statutory subject matter before the twentieth century.

Moreover, the Court expressly stated

> A process is a mode of treatment of certain materials to
> produce a given result. It is an act, or a series of acts,
> performed upon the subject-matter to be transformed and
> reduced to a different state or thing. If new and useful, it is just
> as patentable as is a piece of machinery.

Cochrane v. Deener, 94 U.S. 780, 787-788 (1877). There is nothing to suggest that anything other than an act or series of acts is necessary for a process to be statutory subject matter. When the judicial precedent for processes being included in the patentable subject matter was codified in the Patent Act of 1952, no requirement for anything other than a process was set forth in the statute, just as none exists today under 35 U.S.C. § 101. Accordingly, Appellant respectfully asserts that claims 9-15 set forth a patentable process which comprises statutory subject matter under 35 U.S.C. § 101.

However, in an effort to expedite issuance of the present application, Appellant amended independent claim 9 in the Amendment After Final Rejection filed on March 17, 2005 to recite "storing, by a computer, a list of prohibited expressions" and "filtering said document using said computer." Claims 10-15 depend from claim 9. Appellant believes that the foregoing should overcome the Appellee's stated, although unsupported, reason for rejecting the claims.

The Advisory Action did not address the foregoing amendment, other than indicating that it would be entered. The Advisory Action indicated that the application was not in condition for allowance, but only gave the 35 U.S.C. § 103 rejection as a reason for withholding allowance. As a result, Appellant is uncertain as to whether the Appellee intends to maintain the 35 U.S.C. § 101 rejection of claims 9-15 in light of the amendment to claim 9.

C.   35 U.S.C. § 103 Rejections

Claims 1, 9, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre,* in view of *DeStefano.* Claims 2-5, 7, 10-12, and 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and further in view of Cragun et al., United States patent number 5,832,212 (hereinafter *Cragun*). Claims 6, 13, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and *Cragun* and further in view of Aras et al., United States patent number 5,757,417 (hereinafter *Aras*). Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and *Cragun* and further in view of Halim et al., United States patent number 6,304,881 (hereinafter *Halim*). Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and further in view of Dieterman, United States Patent number 6,393,464 (hereinafter *Dieterman*). Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lapierre* in view of *DeStefano* and *Cragun* and further in view of *Dieterman.*

To establish a *prima facie* case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the second criteria, Appellant respectfully asserts that the references lack proper motivation to combine in addition to lacking all the claim limitations.

1.   The Independent Claims

Appellant has repeatedly pointed out that *Lapierre* does not teach or suggest censoring a <u>document</u> or finding restricted terms or expressions in a <u>document</u> as set forth in independent claims 1, 9, and 16. In response, the Appellee states that "the text data content contained in the signal [of *Lapierre*] could easily be considered a document," the final Office Action at page 9. Whether or not the text data content of *Lapierre* <u>could</u> be considered a document is not dispositive with respect to the patentability of the present claims. The Appellee carries the burden of showing that one of ordinary skill in the art <u>would</u> have understood the text data content of *Lapierre* had to be a document as set forth in the claims, without the benefit of hindsight based upon Appellant's disclosure, see M.P.E.P. § 706.02(j). Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 1, 9, and 16 and the claims dependent therefrom.

Claim 1 recites "a text highlighter program for highlighting said restricted terms found in said document" and claims 9 and 16 recite "visibly marking ones of said prohibited expressions found in said document." As previously asserted by Appellant, the express purpose of the closed caption censor of *Lapierre* is to "remov[e] objectionable language from the closed caption and audio portions of programming displayed on a television," column 1, line 67, through column 2, line 2, such as to "regulate the programming content seen by children," column 1, line 14. Yet the Appellee asserts that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to have highlighted words with a special condition in *Lapierre* in the manner of *DeStefano* in order to draw attention to them," see the final Office Action at page 3. Accordingly, rather than removing the objectionable language, as required for the principle of operation of *Lapierre*, the modification proposed by the Appellee would highlight the objectionable language "in order to draw attention to them."

"It is improper to combine references where the references teach away from their combination," M.P.E.P. § 2145. Moreover, the proposed modification or combination of the prior art cannot render the prior art unsatisfactory for its intended purpose, M.P.E.P. § 2143.01. The 35 U.S.C. § 103 rejection of record based upon modification of *Lapierre* in view of *DeStefano* is in direct contravention to the law because *Lapierre* teaches away from the combination and because the proposed modification would render the system of *Lapierre* unsatisfactory for its intended purpose. Moreover, in the present situation it follows, *a*

fortiori, that one of ordinary skill in the art would not have been led to draw the attention of a viewer, such as a child, to highlighted objectionable text in the closed captioning displayed by *Lapierre*.

In response to Appellant's previously submitted arguments, the Appellee states that "[e]ven if small details of the two inventions are not immediately compatible, obvious combinations of the general principles contained in the inventions could have easily been combined to produce a combined invention which would have satisfied the limitations of the claims," see the final Office Action at pages 9-10. The foregoing is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, M.P.E.P. § 2143.01 (citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). Accordingly, the motivation provided by the Appellee is improper, as the motivation must establish the desirability for making the modification.

Appellant asserts that a *prima facie* case of obviousness under 35 U.S.C. § 103 over *Lapierre* and *DeStefano* has not been established with respect to claims 1, 9, and 16 and the claims dependent therefrom. Moreover, the rejections of record relying upon various combinations of *Lapierre*, *DeStefano*, *Cragun*, *Aras*, *Halim*, and *Dieterman* do not cure the above identified deficiency in the *prima facie* case of obviousness.

2. The Dependent Claims

Dependent claims 2-8, 10-15 and 17-20 depend directly or indirectly from a respective one of claims 1, 9 and 16. The disclosures of *Cragun*, *Aras*, *Halin*, and *Dieterman* have not been cited by the Appellee to meet, nor does Appellant believe that *Cragun*, *Aras*, *Halin*, and *Dieterman* meet, the above deficiencies in the disclosures of *Lapierre* and *DeStefano* identified above with respect to the independent claims. Accordingly, the dependent claims are asserted to be patentable over the 35 U.S.C. § 103 rejections of record at least for the reasons set forth above with respect to claims 1, 9 and 16. Moreover, these dependent claims set forth additional new and non-obvious limitations not present in the art of record.

a.   *Lapierre, DeStefano* and *Cragun* Fail to Teach or Suggest
        Every Limitation of Claims 2 and 17

Claim 2 recites, in part, "a generalization database of non-restricted terms, wherein ones of said non-restricted terms correspond to ones of said restricted terms." Similarly, claim 17 recites, in part, "means for presenting a group of said generalized expressions corresponding to ones of said restricted expressions found in said document." The final Office Action admits that *Lapierre* and *DeStefano* do not teach having a document sensor comprising such a database, and attempts to cure this deficiency by introducing *Cragun*.

In rejecting claim 2, the final Office Action states on page 4:

> [I]t was notoriously well known in the art at the time of the invention that a database is an organized and efficient way to manage lists of words used for replacement, so it would have been obvious to one of ordinary skill in the art at the time of the invention to have used alternative words for replacement in *Lapierre* and *DeStefano* in the manner of *Cragun* and to have stored them in a database because this would have produced a more acceptable document and have done so in an organized and efficient manner.

With regard to claim 17, the Office Action merely states that claim 17 is rejected under similar rationale as claim 10, and that claim 10 is rejected under similar rationale as claim 2.

The proposed combination, in addition to not curing the deficiencies identified above with respect to *Lapierre and DeStefano*, does not teach the limitations of claims 2 or 17. *Cragun* teaches that the list of replacement words should provide a "socially acceptable substitute" for an offensive word, not a generalized term. *Cragun*, column 5, lines 26-28 and column 6, lines 55-59. Accordingly, *Cragun* merely teaches replacing an offensive word with a substitute having the same meaning and conveying the same information, albeit in a socially acceptable form. However, the claim language above expressly recites generalized terms or expressions. *Cragun* does not teach or suggest that offensive words should be replaced with a generalized term, and the rejections of claims 2 and 17 should be withdrawn.

b.   *Lapierre, DeStefano* and *Cragun* Fail to Teach or Suggest
        Every Limitation of Claim 4

Claim 4 recites, in part, "wherein said text comparator program finds ones of said restricted terms via rules-based relationships." Appellant asserts that the combination of

Lapierre and *DeStefano* and *Cragun* does not teach at least this aspect or limitation of claim 4. The Office Action points to lines 10-20 of the Abstract of *Cragun*. However, *Cragun* does not teach finding restricted terms via rules-based relationships. Rather, *Cragun* teaches finding "words and word fragments matching user selected words and word fragments," which is a simple, template-matching approach. *Cragun*, Abstract, lines 10-11. That is, *Cragun* does not teach or suggest making a censorship decision based on combinations of words that, if occurring individually, would not necessarily result in the same decision. *Cragun* limits the use of "rules stored in a user profile" for display options. *Cragun*, column 3, lines 54-62. Therefore, claim 4 contains limitations not taught or suggested by the references of record, and the rejection of claim 4 should be withdrawn.

> c.   *Lapierre*, *DeStefano* and *Cragun* Fail to Teach or Suggest Every Limitation of Claims 10 and 17, and the Proposed Modification Renders the References Unsatisfactory for their Intended Purposes

Claim 10 recites, in part, "storing a list of alternate expressions corresponding to said prohibited expressions; and presenting a group of said alternative expressions." Claim 17 recites, in part, "means for presenting a group of said generalized expressions corresponding to ones of said restricted expressions found in said document." Appellant asserts that the combination of *Lapierre* and *DeStefano* with *Cragun* does not teach at least these aspects of claims 10 and 17.

Nothing in the combination of *Lapierre*, *DeStefano* and *Cragun* teaches or suggests presenting a group of alternative expressions for restricted terms or presenting a group of generalized expressions corresponding to ones of restricted expressions. *Lapierre* teaches deletion, *DeStefano* does not teach censorship, and *Cragun* teaches setting up a user profile so that the web browser would select a single operation for all offensive words, such operation being one of: blank out with asterisks, show the first letter of the word followed by asterisks, or automatically replace with the offensive word with the pre-selected "socially acceptable substitute." *Cragun*, column 5, lines 26-28 and column 6, lines 55-59. The web browser in *Cragun* specifically attempts to shield the user from exposure to offensive words, and blocks or replaces the word with a single, possible substitute prior to displaying the filtered text. *Cragun*, column 3, lines 54-59, stating "before any text is displayed." See also

T condition of 510 through F condition of 542 in figures 5A and 5B. That is, *Cragun* does not teach providing any group or alternatives for censored words.

Additionally, since the method of censorship taught by *Lapierre* is performed in real-time for the display of closed-caption text, presenting a group of alternative or generalized expressions for selection by a viewer may not be possible within acceptable time constraints, and certainly not without altering the principle of operation of *Lapierre*. See figure 1 of *Lapierre*. *Lapierre* shows a Mute going to the Audio Switch, which is consistent with the operation operating in a time-critical manner without sufficient time for a presentation of alternative or generalized expressions for selection by a viewer. The proposed modification, then, renders *Lapierre* unsatisfactory for its intended purpose of automatically censoring offensive words in real-time.

Also, since the purpose of *Lapierre* and *Cragun* is to shield users from offensive words, presenting a group of alternatives would draw focus and additional attention to fact that a word appearing on the censorship list has been found. Further, to make a presentation of alternatives meaningful, the user would need to be shown the censored word in order to select the replacement. Because *Lapierre* and *Cragun* do not teach displaying the censored words, presenting a group or alternatives as Appellee proposes has no purpose. Otherwise, presenting a group or alternatives in a meaningful way would render both *Lapierre* and *Cragun* unsatisfactory for their intended purposes.

Therefore, claims 10 and 17 contain features and limitations not taught or suggested by the combination of references, and thus, the rejections of claim 10 and 17 should be withdrawn.

> d.   Combining *Lapierre*, *DeStefano* and *Cragun* with *Aras* for Claims 6, 13 and 20 Renders the References Unsatisfactory for their Intended Purposes

Claim 6 recites that the "censor provides alternative ones of said non-restricted terms to a user for selectively replacing said restricted terms found in said document." Claim 13 recites, in part, "selecting a corresponding alternate expression from said presented group of said alternate expressions." Claim 20 recites, in part, "means for selecting a corresponding generalized expression from said presented group of said generalized expressions." In

addressing these aspects of the claims, the Appellee concedes that the combination of *Lapierre, DeStefano* and *Cragun* does not meet the claims. Accordingly, the rejection of record with respect to claim 6 introduces *Aras*, stating that " it would have been obvious ... to have incorporated the feature of choosing alternative information units from *Aras'* invention into *Lapierre, DeStefano and Cragun's* invention in order to allow selective replacement of terms by the user." The rejections of claims 13 and 20 rely upon the rejection of record with respect to claim 6.

Aras teaches only responding to a limited set of screening classification codes (SCCs) or categories in a channel classification table (CCT) that describe content in general. *Aras*, column 3, lines 5-15 and 26-29. Additionally, all user choices in *Aras* are finalized before any censorship filtering begins. *Aras*, column 13, lines 1-5. But to make a selection of alternatives meaningful for specific censored content, however, the user would need to be shown the censored content to select the replacement. As with *Lapierre* and *Cragun*, the purpose of *Aras* is to shield viewers from offensive content. *Aras*, column 3, lines 30-35. Because *Aras* does not teach displaying the censored content, selecting from a group or alternatives has no purpose in the context of *Aras*. Otherwise, selecting from a group or alternatives in a meaningful way would render *Aras* unsatisfactory for its intended purposes.

Further, the language of the recited motivation is circular in nature, stating that it is obvious to make the modification (present multiple choices of terms for selection by a user) because it is obvious to achieve the result (allow selective replacement of terms by the user). Such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Thus, the motivation provided by the Appellee is improper, as the motivation must establish the desirability for making the modification. Therefore, the rejections of claims 6, 13 and 20 should be withdrawn.

　　　　e.　　Lack of Motivation to Combine *Lapierre, DeStefano* and
　　　　　　　Cragun with *Halin* for Claim 8

Claim 8 recites, in part, "wherein said censor database and said generalization database are accessible by remote users." The final Office Action admits that the combination of *Lapierre, DeStefano,* and *Cragun* does not teach such access by remote users, and attempts to cure this deficiency by introducing *Halin. Halin,* however, is in an entirely different field of invention. *Halin* addresses access of e-mail files from a home-based computer. *Halin* column 1, lines 9-12. The final Office Action merely states, "It would have been obvious ... to have the databases ... accessible by remote users ... to improve the availability of the databases." Appellant asserts that this is insufficient motivation for combining *Halin* with the fields of closed captioning censorship, concept abstraction, and webpage censorship. *Lapierre* teaches an end-user device on the receiving end of a television broadcast. *Lapierre,* column 4, line 67 to column 5, line 2, and Figures 1-3. *DeStefano* does not deal with censorship or the need for remote users. *Cragun* does not suggest that any need exists for improving the availability of the "user profile" containing the list of word to be censored.

That is, the modification suggested by Appellee is not compatible with *Lapierre,* not related to *DeStefano,* and not needed by *Cragun.* Since the prior art does not suggest the desirability of making such a modification, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established, and the rejection of claim 8 should be withdrawn.

　　　　f.　　*Lapierre, DeStefano, Cragun* with *Dieterman* Fail to Teach or
　　　　　　　Suggest Every Limitation of Claim 15

Claim 15 recites, in part, "said storing said list of alternate expressions is restricted to at least one predetermined administrator." As shown above for claims 10 and 17, the combination of *Lapierre, DeStefano* and *Cragun* does not teach or suggest the use of alternate replacement expressions. Applicant asserts that *Dieterman* does not cure this deficiency. Therefore, the combination of references does not teach or suggest all claim limitations, and the rejection of claim 15 should be withdrawn.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A reflect the Amendment After Final Rejection filed on March 17, 2005.

IX. EVIDENCE

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the Appellee is being submitted.
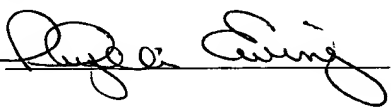
X. RELATED PROCEEDINGS

No related proceedings are referenced in II. above, or copies of decisions in related proceedings are not provided, hence no Appendix is included.

Appellant believes that no fee is due with this response. However, if there is any amount due, please charge Deposit Account No. 08-2025, under Order No. 10004840-1 from which the undersigned is authorized to draw.
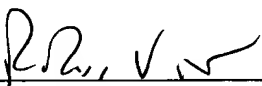
I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail Airbill No. EV629198005US, in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: 06/21/2005

Typed Name: Phyllis Ewing

Signature:

Respectfully submitted,

By R. Ross Viguet
Attorney/Agent for Applicant(s)
Reg. No.: 42,203

Date: 06/21/2005

Telephone No. (214) 855-8185

APPENDIX A

Claims Involved in the Appeal of Application Serial No. 09/822,152

1.   (Original) A computerized document censor comprising:

a censor database of restricted terms;

a text comparator program for finding ones of said restricted terms in said document; and

a text highlighter program for highlighting said restricted terms found in said document.

2.   (Original) The document censor of claim 1 further comprising:

a generalization database of non-restricted terms, wherein ones of said non-restricted teens correspond to ones of said restricted terms.

3.   (Original) The document censor of claim 1 wherein said restricted terms comprise at least one of:

single words;

phrases; and

numbers.

4.   (Original) The document censor of claim 1 wherein said text comparator program finds ones of said restricted terms via rules-based relationships.

5.   (Original) The document censor of claim 1 wherein said non-restricted terms are gathered into said generalization database by a user.

6.   (Original) The document censor of claim 2 wherein said censor provides alternative ones of said non-restricted terms to a user for selectively replacing said restricted terms found in said document.

7.   (Original) The document censor of claim 2 further comprising:

a text editor for replacing said restricted terms found in said documents with selected ones of said non-restricted terms.

8.   (Original) The document censor of claim 2 wherein said censor database and said generalization database are accessible by remote users.

9.   (Previously Presented) A method for censoring a document comprising the steps of:

storing, by a computer, a list of prohibited expressions;

filtering said document using said computer to find ones of said prohibited expressions; and

visibly marking ones of said prohibited expressions found in said document.

10.   (Original) The method of claim 9 further comprising the steps of:

storing a list of alternate expressions corresponding to said prohibited expressions;

and presenting a group of said alternative expressions corresponding to ones of said prohibited expressions found in said document.

11.   (Original) The method of claim 9 wherein said storing said list of said prohibited expressions step comprises at least one of the steps of:

entering prohibited words;

entering prohibited phrases; and

entering rules of prohibited communication relationships.

12.   (Original) The method of claim 10 wherein said storing said list of said alternate expressions step comprises at least one of the steps of:

entering alternate words;

entering alternate phrases; and

entering rules of alternate communication relationships.

13.   (Original) The method of claim 10 further comprising the steps of:

selecting a corresponding alternate expression from said presented group of said alternate expressions; and

replacing said prohibited expression found in said document with said selected corresponding alternate expression.

14.   (Original) The method of claim 9 wherein said storing said list of prohibited expressions is restricted to at least one predetermined administrator.

15.   (Original) The method of claim 10 wherein said storing said list of alternate expressions is restricted to at least one predetermined administrator.

16.   (Original) A computer program product having a computer readable medium having computer program logic recorded thereon for reviewing a document for restricted expressions comprising:

means for storing a list of said restricted expressions;

means for searching said document to find ones of said restricted expressions; and

means for visibly marking ones of said restricted expressions found in said document.

17.   (Original) The computer program product of claim 16 further comprising:

means for storing a list of generalized expressions corresponding to said restricted expressions; and

means for presenting a group of said generalized expressions corresponding to ones of said restricted expressions found in said document.

18.   (Original) The computer program product of claim 16 wherein said means for storing said list of said restricted expressions comprises at least one of:

means for entering restricted words;

means for entering restricted phrases; and

means for entering rules of restricted communication relationships.

19.   (Original) The computer program product of claim 17 wherein said means for storing said list of said generalized expressions comprises at least one of:

means for entering generalized words;

means for entering generalized phrases; and

means for entering rules of generalized communication relationships.

20.   (Original) The computer program product of claim 17 further comprising:

means for selecting a corresponding generalized expression from said presented group of said generalized expressions; and

means for replacing said restricted expression found in said document with said selected corresponding generalized expression.